

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

APR 15 1999

In re

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Decision on
Petition for Review
Under 37 CFR § 10.2(c)

MEMORANDUM AND ORDER

(petitioner) seeks review of the decision of the Director, Office of Enrollment and Discipline (OED), dated August 7, 1998, denying petitioner's request for a higher score on the morning section of the Examination to Practice in Patent Cases Before the U.S. Patent and Trademark Office held on August 27, 1997. The petition is *denied*.

BACKGROUND

An applicant for registration to practice before the Patent and Trademark Office (PTO) in patent cases must achieve a passing grade of 70 in both morning and afternoon sections of the examination. Petitioner scored a 68 for the morning section. The Director did not add any points to petitioner's score in her regrade decision. Thus, to achieve a passing grade, Petitioner must acquire two additional points, equal to one question, on the morning section of the examination.

In his September 9, 1998, Petition to the Commissioner, Petitioner challenges the Director's grading of two questions in the morning section. Specifically, petitioner requests review of his answers to questions 25 and 49.

OPINION

Pursuant to 37 CFR 10.7(c), Petitioner must particularly point out the errors which the applicant believed occurred in the grading of his or her examination in the request for regrade. The directions also state that: "[n]o points will be awarded for incorrect answers or unanswered questions." The directions further state that the correct answer is the "most correct answer." The burden is upon the Petitioner to show that his chosen answer is the most correct answer.

Question 25

Question 25 states:

Alice invented a new pharmaceutical compound. You have prepared, filed, and prosecuted a patent application containing Claims 1 through 15 directed to the compound. All of the claims were finally rejected under 35 U.S.C. § 102(b) in view of the Leary Patent. You appealed the final rejection and have received a decision from the Board of Patent Appeals and Interferences affirming the rejection of Claims 1 to 10 in view of Leary and reversing the rejection of Claims 11-15. However, the Board has entered a new ground of rejection of Claims 11-15 under 35 U.S.C. § 103 in view of the Garcia patent. Which of the following is/are correct response(s) to the Boards' new ground of rejection?

- (A) File a request for reconsideration by the Board within one month of the date of the Board decision.
- (B) File a Notice of Appeal regarding the Board's decision respecting claims 1-5 with the U.S. Court of Appeals for the Federal Circuit within 60 days of the date of the decision.
- (C) Submit an amendment to the Examiner that amends Claims 11-15 to avoid the Garcia reference, along with an affidavit providing evidence of the non-obviousness of the claimed compound compared to the compound disclosed by Garcia, within the appropriate time period set in the Board decision.
- (D) Submit an amendment to the examiner amending claim 1 to define over Leary and amending Claims 11-15 to define over the Garcia patent.

(E) Both (A) and (C) are correct.

Petitioner selected answer (A). The correct answer is choice (E), on the basis of 37 CFR § 1.196(b) and MPEP § 1214.01. Answer (E) incorporates two correct answers (A) and (C). Petitioner does not disagree that answer (A) is a correct answer.

Petitioner argues that answer (C) is incorrect because it merely states an intention to avoid the prior art by amendment, not that it actually does avoid the prior art. Petitioner suggests that the answer should have used the term “that avoids” rather than the term “to avoid” the prior art. Petitioner’s argument cannot prevail. Section 1214.01 of the MPEP states that an applicant may amend the claims “to avoid the [prior] art,” the same terminology employed by answer (C). Thus, model answer (E) is the correct answer to question 25.

Question 49

Question 49 states:

In response to a final rejection dated February 4, 1997, with a three month shortened statutory period for response, you call the examiner in charge of the patent application to schedule a first interview on July 3, 1997, to discuss further narrowing the scope of claim limitations. Your request for an interview should be _____

- (A) denied because your request is after the expiration of the shortened statutory period for response.
- (B) granted only if applicant pays the extension fee for the expired time.
- (C) granted.
- (D) denied because interviews are not permitted after the final Office action.
- (E) granted only if you have a proposed amendment and pay the extension fee.

Petitioner selected answer (B). The correct answer is choice (C), on the basis of MPEP §§ 706.07(f) and 713.09. Petitioner does not argue that he correctly chose answer (B). Instead, petitioner argues that the question is defective with no correct answer.

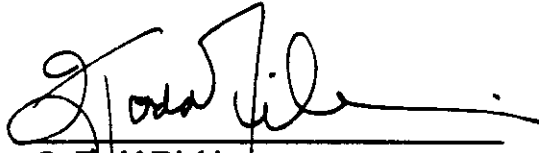
The MPEP clearly states “Interviews may be conducted after the expiration of the shortened statutory period for response to a final office action but within the 6-month statutory period for response *without* the payment of an extension fee.” MPEP § 706.07(f)(M) (emphasis in original). Additionally, MPEP § 713.09 states “Normally, one interview after final rejection is permitted.” That section further states that an interview may be held after the expiration of the shortened statutory period for response without an extension of time. Thus, answers (A), (B), (D) and (E) are all incorrect because they either state that interviews are not permitted after final, or after the shortened statutory period for response, or require payment of a fee to extend the time for a response—all matters contradicted by the MPEP. Curiously, despite the clear language of the MPEP sections cited, Petitioner argues that an extension fee must be paid. Answer (C) is the best, and only, correct answer of the five possible answers presented. As the MPEP notes, one interview is normally granted after a final rejection.

Petitioner also suggests that answer (C) is defective because it does not affirmatively state that the applicant’s proposed narrowing of claims would not require a new examiner search or more than nominal considerations by the examiner. This argument is unpersuasive. In order for answer (C) to be defective, Petitioner must assume facts not contained in the question. Such assumptions are not allowed. Answer (C) is neither impossible nor incorrect, without assuming facts to make it incorrect. Petitioner had to select the most correct answer, which he has failed to do.

ORDER

Upon consideration of the petition to the Commissioner, it is

ORDERED that the petition is denied.

A handwritten signature in black ink, appearing to read "Q. Todd Dickinson", written over a horizontal line.

Q. Todd Dickinson

Acting Assistant Secretary of Commerce

and Acting Commissioner of Patents and Trademarks